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| EXAMINER | |
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| DADA, BEEMNET W | |
| **ART UNIT** | **PAPER NUMBER** |
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* JAMES THOMAS EDWARD MCDONNELL,
ANDREW THOMAS, MICHAEL P. SPRATT,
JOHN DERYK WATERS, and SIMON E. CROUCH

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Appeal 2008-0458
Application 09/816,683
Technology Center 2100

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Decided: July 31, 2008

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Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
THU A. DANG, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-18 and 24-32. Claims 19-23 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

## BACKGROUND

Appellants' invention relates to providing location data about a mobile entity. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. A method of billing for location data that represents the location of a mobile entity, wherein:
>
> the location data is provided in encrypted form by a location server to a recipient that is one of the mobile entity and a service system for providing a location-based service to the mobile entity using said location data as an input, the location data being encrypted such that it cannot be decrypted by the recipient;
>
> the encrypted location data is subsequently passed by said recipient to a decryption entity that is not under the control of a user of the recipient; and
>
> the decryption entity decrypts the location data and generates a billing record in respect of the location data.

## PRIOR ART

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

| | | |
|---|---|---|
| Pirilä | US 6,674,860 B1 | Jan. 6, 2004 |

## REJECTIONS

Claims 1-5, 7-12, 14, 16-18, 24-28 and 30-31 stand rejected under 35 USC § 102(e) as being anticipated by Pirilä.

Claims 6, 13, 15, 29 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Feb. 23, 2007) for the reasoning in support of the rejection, and to Appellants' Brief (filed Sep. 11, 2006) and Reply Brief (filed Feb. 6, 2007) for the arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have carefully considered Appellants' Specification and claims, the applied prior art reference, and the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we determine the following.

At the outset, we note that Appellants have only set forth arguments with respect to independent claim 1. As discussed *infra*, we find Appellants' arguments to be persuasive with respect to independent claim 1, and we find similar limitations set forth in independent claims 24 and 31. Therefore, we will limit our discussion to independent claim 1.

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim . . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 1458 (Fed. Cir.

1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571 (Fed. Cir. 1986).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.,* 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

Appellants rely upon the sole issue of whether Pirilä teaches the claimed limitation "location data is provided in encrypted form by a location server to a recipient." Appellants maintain that the teachings of Pirilä are with respect to location information which is related to the base stations rather than the location of a mobile entity as recited in independent claim 1.

(Reply Br. 2). We agree with Appellants that Pirilä merely teaches information other than location data that represents the location of a mobile entity. While Pirilä recognizes the importance of chargeability for the location service according to usage thereof, at columns 1, 3, and 4, we do not find that Pirilä teaches the claimed methodology that tracks the decryption of the information for billing in the manner recited in independent claim 1.

Moreover, we do not find the Examiner's reliance upon prior art methodologies as described in Appellants' admitted prior art at pages 7 and 9 of the Specification clearly relevant to the interpretation of the instant claim language. Furthermore, if the Examiner intends to rely upon Appellants' admitted prior art methodologies as disclosed in Appellants' Specification, this would be inappropriate under a rejection under anticipation based on Pirilä alone. Therefore, we find no persuasive rebuttal by the Examiner to Appellants' argument which we find is based upon the express language of independent claim 1.

Accordingly, we cannot find that the Examiner has set forth a sufficient initial showing of anticipation based upon the teachings of Pirilä alone, and we cannot sustain the rejection of independent claim 1 and its respective dependent claims 2-18. Likewise, we find similar limitations in independent claims 24 and 31 and their respective dependent claims 25-30 and 32. Similarly, we cannot sustain the rejection of claims 24 and 31 and their respective dependent claims 25-30 and 32 based upon the Examiner's lack of a showing of anticipation over Pirilä alone.

## CONCLUSION

To summarize, we have reversed the rejection of claims 1-5, 7-12, 14, 16-18, 24-28 and 30-31 under 35 U.S.C. § 102.

REVERSED

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